REMARKS/ARGUMENTS

Claims 20, 24, 35, 37, 50, 51 and 53-55 are pending in this application. No claims have been amended, added, or cancelled with the filing of this response. Reconsideration is requested in view of the following remarks.

Rejection under 35 U.S.C. § 102(b)

The rejection of claim 53 under 35 U.S.C. § 102(b) as anticipated by Chivukula (US Patent No. 6,066,581) is respectfully traversed for reasons of record and the reasons discussed below.

According to the Office, regarding structural limitations implied by the claimed process that are not taught by the prior art,

> applicants specification only teaches that the uniformity of the grains is the only property of the grains which differs from the prior art. However, as rejected above, uniform grain size is taught by the prior art (see Chivukula). As this property was specifically and explicitly rejected above the examiner did not fail to accord the property weight and consideration. The burden is on the applicant to demonstrate, not merely allege, that the process steps distinguish, not conform, the product from the prior art. MPEP 2113. In re Thorpe.

Present Office Action at pages 9-10, paragraphs 33 to 36.

However, Applicants point out that not only is the claimed grain-sized distribution evidenced by the specification, but it is further described that coating the particles as presently claimed prevents the particles from aggregating. *See* present specification, e.g., at page 9, lines 11-12. Moreover, the solution or dispersion phase of the particles, which is removed after heating, results in a condensed/closely packed arrangement of the particles (i.e., the film) on a substrate, i.e., the resulting grains of the present claims are significantly different than those formed by physical deposition processes and sol-gel processes, as described by Chivukula. *See id.* at page 11, lines 24-27.

As such, the reference does not describe the dielectric thin film, and therefore the rejection is improper. Reconsideration and withdrawal are respectfully requested.

Rejections under 35 U.S.C. § 103

The rejection of claims 20, 24, 35, 37, 50, 51, 53-55 are rejected under 35 U.S.C. § 103(a) as obvious over Leung (US Published Patent Appl. No. 2002/0137260) in view of Matijevic (US Patent No. 5,900,223); and the rejection of claim 54 as obvious over Leung in view of Matijevic and further in view of Yokouchi (US Patent No. 5,143,637) are respectfully traversed for reasons of record and the reasons discussed below.

According to the Office, in "response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning." Present Office Action at page 10, paragraph 38. The Office also asserts that it "recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art . . . In this case, Matejevic teaches powders useful for making dielectrics that have superior dielectric properties, size uniformity, and sinterability." *Id.* at paragraph 39.

However, Applicants point out that an obviousness analysis requires that the Office make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." *See In re Ward and Murphy*, Appeal No. 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original)*; see also Ex parte Martin Haubner and Rolf Pinkos*, Appeal No. 2009-0449 (reversing an obviousness rejection and explaining that "the examiner bears the initial burden of presenting a case of prima facie obviousness"). Moreover, the Supreme Court has indicated, *inter alia*, that there must be some reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1731, 1741 (2007).

In the present case, Applicants assert that when the features of the claimed dielectric film are compared to the disclosures of the references of record, it is evident that the claimed film differs from **Leung** (i.e., only mentions that surfactants may be present as a possible additive in a

dispersion and not the claimed arrangement or results of a solution or dispersion of surfactant-coated nanoparticles in an organic solvent), **Matijev** (i.e., no description of a surfactant coating or relation to the matrix material infiltration Leung that would result in the claimed dielectric thin film), and **Yokouchi** (i.e., relating only to a low-viscosity magnetic fluid, which is clearly unrelated to the claimed film). Further, other than conclusory statements of obviousness, the Office has not established its initial burden of proving obviousness or provided any apparent reason that would have prompted a person of ordinary skill to combine the elements or modify the references in the manner presently claimed.

Therefore, the rejections are improper and should not be maintained. Accordingly, withdrawal and reconsideration of the rejections are requested.

In view of the above remarks, Applicant believes the pending application is in condition for allowance.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0510, under Order No. YOR920010225-US2 from which the undersigned is authorized to draw.

Dated: March 29, 2010

Respectfully submitted,

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